

REMARKS

Claims 1-18 are pending in the present application.

At the outset, Applicants wish to thank Examiner Elhilo for the helpful and courteous discussion with their undersigned representative on December 21, 2004. During this discussion various arguments in traverse of the outstanding rejection were discussed. The content of this discussion is reflected in the following comments. Reconsideration of the outstanding rejections is requested.

The rejection of Claims 1-6 under 35 U.S.C. §102(b) over Mikoshiba et al is obviated by amendment.

Although the scope of the claimed invention contains a minor overlap with compounds within the scope of formulae (II) and (III)¹ defined in Mikoshiba et al, this reference fails to provide sufficient motivation to select the compounds falling within the scope of the claimed invention over any other dye disclosed therein. Specifically, Applicants note that every exemplified compound with the exception of Dye 31 and Dye 127 contain an $-NR^5R^6$ group at position X. Applicants further note that even though Dye 31 (formula (I)) and Dye 127 (formula (III)) contain a hydroxyl group at position X, neither of these dyes fall within the scope of the claimed invention. Accordingly, Applicants submit that even with the disclosure of Mikoshiba et al in hand, the skilled artisan would have no reasonable basis to select a dye compound within the scope of the present invention. Moreover, Applicants note that the skilled artisan would not appreciate the advantages flowing therefrom, which are highlighted in Examples 1-4 of the specification.

¹ Formula (III) is cited in regard to A being Cp-7 and Formula (II) is cited in regard to A being Cp-9 [improperly listed as Cp-10 in the Office Action].

Nonetheless, to provide expedient examination of the present application the claims have been amended to remove from the list of alternatives for substituent A: Cp-7 and the first permissible ring-system defined for Cp-9 on page 18 of the specification and original Claim 5. However, Applicants preserve the right to pursue, without prejudice, claims in which substituent A is either Cp-7 or Cp-9 in an ensuing continuation application. Applicants remind the Examiner that the standard for determining anticipation requires that the reference "must teach every element of the claim" (MPEP §2131). In view of the present amendment to remove the compounds that overlap with the disclosure of Mikoshiba et al, Applicants submit that Mikoshiba et al cannot anticipate the claimed invention.

In addition, Applicants note that new Claims 7-18 depend from Claim 1, which should allowable over the disclosure of Mikoshiba et al. As such, Claims 7-18 should be entered and allowable by dependency.

Applicants request withdrawal of this ground of rejection.

Accordingly, Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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